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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,146	09/26/2005	Scott Murphy	584542000200	9164

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EXAMINER
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ATALA, JAMIE JO

ART UNIT	PAPER NUMBER
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2621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,146	<b>Applicant(s)</b> MURPHY, SCOTT	
	<b>Examiner</b> JAMIE JO VENT ATALA	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-14, 20 and 23 rejected under 35 U.S.C. 102(e) as being unpatentable by Tsukamoto et al (US 2002/0013940)..

[claim 1]

In regard to Claim 1, Tsukamoto et al discloses a method for supplying digital files to the customer via a data communications network, comprising

- providing a recordable medium to a customer (Figures 4 and 5 shows the recording device);
- registering details of the customer and the recordable medium in a data bank (Paragraphs 130-134 describes the information needed in order to register and provide download of content);
- receiving a customer request to supply one or more digital files (Paragraph 134 describes the user wanting to get content from the system);

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- authenticating the recordable medium and the identity of the customer (Paragraphs 0129-0135 describes the authenticating of the data), and
- if authentication is successful, supplying the requested one or more digital files from the data bank to a client terminal via the data communications network for record on the recordable medium (Paragraphs 0134-0140 describes the successful transmission of data to the user).

[claim 4]

In regard to Claim 4, Tsukamoto et al discloses a method wherein the digital files are music files or other video, audio or data content (paragraphs 0085-0089).

[claim 5]

In regard to Claim 5, Tsukamoto et al discloses a method according wherein the recordable medium supplied to the customer includes one or more pre-recorded digital files (Paragraphs 0085-0089 describes the content sent to the user wherein the data is rented movies that are pre-recorded).

[claim 6]

In regard to Claim 6, Tsukamoto et al discloses a method according wherein the recordable medium includes a recordable medium identifier (paragraphs 0130-0135 describes the identifier used for identifying content to the recording medium).

[claim 7]

In regard to Claim 7, Tsukamoto et al discloses a method according to comprising: registering the recordable medium identifier and the customer details in the data bank in

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step, and detecting the recordable medium identifier from the recordable medium (Paragraphs 0130-0134 describes the registering of user and system data).

[claim 8]

In regard to Claim 8, Tsukamoto et al discloses a method according to any wherein the customer details include a customer name and password (Paragraph 0080).

[claim 9]

In regard to Claim 9, Tsukamoto et al discloses a method wherein step includes: receiving customer entered validation data, and comparing the validation data to the customer name and password stored in the data bank (Paragraphs 0130-0134).

[claim 10]

In regard to Claim 10, Tsukamoto et al discloses a method wherein the data bank is maintained by a predetermined content supplier (Paragraphs 0125-0140 describes the content supplier).

[claim 11]

In regard to Claim 11, Tsukamoto et al discloses a method further comprising: receiving the customer request an intermediary server; identifying the predetermined content supplier, and directing the customer request to the data bank of that predetermined content supplier (Paragraphs 0125-0140 describes the content data being processed).

[claim 12]

In regard to Claim 12, Tsukamoto et al discloses a method wherein the recordable medium includes a content supplier identifier (Paragraphs 0125-0140 describes the content supplier).

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[claim 13]

In regard to Claim 13, Tsukamoto et al discloses a method comprising: identifying the predetermined content supplier by detecting the content supplier identifier at the intermediary server (Paragraphs 0125-00140).

[claim 14]

In regard to Claim 14, Tsukamoto et al discloses a method comprising: issuing the manufacturer and retailer with unique identifying codes (Paragraph 0080-0090 describes the unique identifiers associated with the system).

[claim 20]

In regard to Claim 20, Tsukamoto et al discloses a method comprising: providing the customer with notification of one or more digital files able to be supplied from the data bank (Paragraphs 0080-0100 describes notifying the user).

[claim 23]

In regard to Claim 23, Tsukamoto et al discloses a computer software stored on a readable medium\_for use with a content server forming part of the system for supplying digital files to a customer via a data communications network, the content server including a processing unit and associated memory device for storing the computer software, wherein the computer software acts to cause the content server to carry out a method (Paragraphs 0130-0134 describes the content being delivered as seen in Figure 4).

***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al (US 2002/0013940).

[claim 2]

In regard to Claim 2, Tsukamoto et al discloses a method wherein the recordable medium is a recordable DVD (Figure 5 shows the recording medium to be a HDD and also a set top box. It is well known that set top box and HDD can also contain optical storage medium and thereby the examiner takes official notice that the recording medium could include recordable DVD in order to allow various recording mediums to be interchanged within the system).

[claim 3]

In regard to Claim 3, Tsukamoto et al discloses a method wherein the recordable DVD is connected to the client terminal by a recordable DVD drive (Figure 5 shows the recording medium to be a HDD and also a set top box. It is well known that set top box and HDD can also contain optical storage medium and thereby the examiner takes official notice that the recording medium could include recordable DVD).

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5. Claims 15-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al (US 2002/0013940) in view of Simmons (US 2002/0112172).

[claim 15]

In regard to Claim 15, Tsukamoto et al discloses a method comprising processing information for the customer (Paragraphs 0080-0090 describes the customer detailed information); however, fails to disclose the data being processed is customer payment for the one or more digital files. Simmons teaches a system for processing payment information as described in paragraphs 0002-0015. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to use the customer database system, as taught by Tsukamoto et al, and further incorporate a system that provide payment data, in order to provide an effective and secure method for payments.

[claim 16]

In regard to Claim 16, Simmons disclose a method wherein the customer payment is processed when the recordable medium is provided to the customer (Paragraphs 0002-0015 describe customer information).

[claim 17]

In regard to Claim 17, Tsukamoto et al discloses a method wherein the customer payment relates to the pre-recorded digital files only (Paragraphs 0002-0015 describe customer information).

[claim 18]



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In regard to Claim 18, Tsukamoto et al discloses a method wherein the customer payment relates to the pre-recorded digital files and one or more digital files (Paragraphs 0002-0015 describe customer information).

[claim 19]

In regard to Claim 19, Tsukamoto et al discloses a method wherein the customer payment processed when a customer request (Paragraphs 0002-0015 describe customer information).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Fujimoto et al (US 7,090,581).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE JO VENT ATALA whose telephone number is (571)272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMIE JO VENT ATALA/  
Examiner, Art Unit 2621